

Docket No.: 19036/40796  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of:  
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: (national stage application of  
PCT/JP2004/008710, filed June 21, 2004)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

**REQUEST FOR RECONSIDERATION OF SECOND RENEWED PETITION**  
**UNDER 37 CFR 1.47(B)**

MS PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Decision on assignee's petitions under 37 CFR 1.47(b) (renewed petition) and 1.59(b), mailed October 1, 2008, the assignee respectfully requests reconsideration of its second renewed petition under 37 CFR 1.47(b). The Decision dismissed the assignee's renewed petition under 37 CFR 1.47(b) and set a two month extendable period within which to request reconsideration. This request for reconsideration of the second renewed petition is timely, as it is filed within the two month period set by the petition dismissal.

The assignee continues to rely on material filed in support of the original and renewed petition and incorporates such material herein by reference.

The Decision on (renewed) Petition alleged that assignee has not provided sufficient proof of its "sufficient proprietary interest" in the application. Specifically, the Decision refers to the three differences between the priority document (Japanese Patent Application No. 2003-176965, filed June 20, 2003) and the present application (which is a

U.S. national phase of International Patent Application No. PCT/JP2004/008710). These differences were identified from a red-line comparison document that assignee submitted on May 20, 2008, as Appendix 1. The three differences are: “various” was changed to “variable” in the Background section; “elements” was changed to “means” in the section heading “Means to Solve the Problem;” and “tonicity agent” was changed to “isotonizing agent.” The first change is in the Background section, describing the prior art, and further, is merely a grammatical change. The second change is in a section heading, which is not related to subject matter disclosed in the application. Finally, the third change is also merely a grammatical change. Thus, the assignee again submits that none of these changes are substantive, nor do they introduce any new subject matter to the PCT application.

The previous submissions have conclusively established that the invention in the present application was fully described in the priority application. Because Inventor Matsui executed an assignment of the priority document assigning her rights in the invention of the priority document to Kobayashi, and there is no new subject matter in the PCT application that was not in the Japanese priority application, the assignment executed by Inventor Matsui is properly applied to the PCT application. Thus, Kobayashi, as assignee in the present application, does have a sufficient proprietary interest in this application to grant a petition under Rule 1.47(b).

It is already acknowledged that the assignee has shown sufficient evidence of inventor Matsui’s refusal to sign an inventor’s declaration and has supplied all other required documents and evidence for a petition under 37 CFR 1.47(b). It is respectfully requested that the petition under 37 CFR 1.47(b) be granted. If the Patent Office or Petitions Officer wishes to discuss this request further, he is invited to contact the undersigned at the telephone number listed below.

In the event that this request for reconsideration is deemed insufficient to convince the petition’s officer that the existing second renewed petition satisfies the requirements of 37 CFR 1.47(b), the assignee requests the opportunity to submit further evidence.

Should the petitions officer have any questions of form or substance regarding this request, he is urged to contact the undersigned at the number indicated below.

Dated: October 23, 2008

Respectfully submitted,

By: /Shelley C. Danek, Reg. No. 57,712/  
Shelley C. Danek  
Registration No.: 57,712  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
Telephone: (312) 474-6300  
Facsimile: (312) 474-0448  
Agent for Assignee